

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1, 3-14, 16-18, 20, 22-33, and 35-37 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0092004 to Lee et al. ("Lee").

Claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 remain pending in this application, with claims 1, 14, 18, 20, 33, and 37 being the independent claims. Claims 1, 12-14, 17, 18, 20, 30, 33, 36, and 37 are amended, and claims 10, 11, 16, 29, 34, and 35 are cancelled without prejudice or disclaimer. Claims 2, 15, 19, 21, and 38 have been previously cancelled.

Applicants respectfully traverse the rejection of the claims. A *prima facie* case of obviousness has not been established with respect to any of the claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries...[include determining the scope and content of the prior art and]...[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites a system that includes, for example, “...a generation tool comprising a first tool and a second tool, said first tool being a meta data dependent passer element and said second tool being a meta data independent generating element; and input/output means for...invoking said generation tool, said input/output means...enabling editing of said meta data, wherein...said workbench enables the invocation of said generation tool by initiating an import of said set of meta data into said passer element, said passer element handles, interprets, and processes said set of meta data for input to said generating element, [and] said generating element generates, on the basis of said data input, program code for said business process application.” *Lee* fails to disclose or suggest at least these recited features.

Lee discloses a software development tool that includes “a design program 26 and a generator program 28 [that] reside on [a] design computer 12.” *Lee*, paragraph [0034]. “Through a user-friendly graphic user interface, the design program 26 prompts the user for elements of the system design and stores those elements as a design database file 34 which...is passed to the generator program 28 where it is reformatted as an extensible markup language (XML) meta document.” *Lee*, paragraphs [0035]-[0036]. The generator program of *Lee*, i.e., generator program 28, processes the XML meta documents to create “a validated design database file 38 and a system installation program 44, which...[when executed,] generates a generated software application 40.” See *Lee*, paragraph [0039], for example.

Furthermore, *Lee* discloses that universal modeling language (UML) applications develop application designs and can convert these designs into XML meta documents, which may be imported directly into the generator program without processing by the design program. See *Lee*, paragraph [0037]. Therefore, although *Lee* discloses that UML applications can convert design documents into corresponding XML meta documents, no disclosure or suggestion exists within *Lee* that such a UML application, or any other element of the software development tool, could receive a XML meta document, process that received XML meta document, and then input that XML meta document into a generator element that generates program code. Thus, *Lee* fails to disclose or suggest a system in which a workbench “enables the invocation of said generation tool by initiating an import of meta data into [a] passer element” and the passer element “handles, interprets, and processes said set of meta data for input to said generating element,” as recited by claim 1.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined in the Final Office Action, and the differences between the prior art and claim 1 have not been properly ascertained. Accordingly, no reason has been clearly articulated in the Final Office Action as to why the prior art would have rendered claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1, and the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 3-9, 12, and 13 depend from independent claim 1. As such, these dependent claims are allowable for at least the reasons set forth above for claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 3-9, 12, and 13 under 35 U.S.C. § 103(a).

Further, independent claims 14, 18, 20, 33, and 37, although different in scope from independent claim 1, are allowable for at least reasons similar to those set forth above for independent claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 14, 18, 20, 33, and 37 under 35 U.S.C. § 103(a).

Claims 17, 22-28, 31, 32, and 36 depend from the independent claims. As such, these dependent claims are allowable for at least reasons similar to those set forth above. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of dependent claims 17, 22-28, 31, 32, and 36 under 35 U.S.C. § 103(a).

CONCLUSION


In view of the foregoing, Applicant submits that the claims are in condition for allowance. Applicants therefore request the Examiner's reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this paper and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 15, 2008

By:  (Philip J. Hoffman)
46,340
C. Gregory Gramenopoulos
Reg. No. 36,532
(202) 408-4623